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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,426	06/28/2000	RICHARD HILICKI	HEH-2	6100

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/606,426

Applicant(s)

HILICKI ET AL.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8,10-33,35,37,39-58,60,61,63 and 65-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,33,35,37,39-44,58,60,61,63 and 65-70 is/are rejected.
- 7) ☒ Claim(s) 8, 10-32,45-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 33, 44, and 58 have been amended for further examination. Claims 69 and 70 have been added. Claims 7, 9, 34, 36, 38, 59, 62, and 64 have been canceled.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 35, 37, 43, 44, 61, 63, and 68-70 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Andrea (5,031,935).

D'Andrea discloses in Fig. 1-3, a book and method of making a book having a theme comprising: a first book cover (12); a second book cover (14) joined to the first book cover by spine (not shown); wherein the exterior of the first book cover (Fig. 1) defines one aperture (11) not cut all the way through such that a support is provided (Col. 3, lines 32-35); wherein a theme (Col. 3, lines 10-19) is displayed on the first cover (see Fig. 1); a plurality of sheets fastened together and attached to the covers (See Fig. 2); wherein at least one of the plurality of sheets provides pre-printed information (Col. 3, lines 50 and 51) related to the theme; and wherein at least one of the sheets can be blank (Col. 4, lines 1-11); wherein the covers can be made from card stock (Col. 3, lines 35-40).

In regards to Claim 1, wherein the book is “capable of displaying one or more coins related to the theme”, and a “coin receivable” aperture, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the book of D'Andrea is capable of displaying one or more coins, and having apertures that can receive coins.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-6, 39-42, 60, 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Andrea.

D'Andrea discloses a book comprising all the elements as claimed in Claims 1 and 44, and as set forth above. However, D'Andrea does not disclose a book theme relating to geographic region, state, province, countries; wherein the theme related information is a story, non-fictional, or fictional; wherein an aperture is aligned with the cover apertures.

In regards to the **Claims 1-6 and 40-42**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired indicia on the cover and sheets, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the

substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the cover and sheets, since applicant has not disclosed the criticality of having particular indicia, and the invention would operate equally as well with any type of indicia.

In regards to **Claim 39**, it would have been obvious to place the sheet apertures at any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the sheet apertures at any desired location since applicant has not disclosed the criticality of having the apertures at a particular location, and would function equally as well at any location.

In regards to **Claim 60**, it would have been obvious to one having skill in the art to construct the aperture in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been to construct the aperture with any desirable dimension, since applicant has not disclosed the criticality of having a particular size, and invention would function equally as well if constructed in any desirable size.

4. Claims 33 and 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Andrea in view of "ISBN 0-439-20822".

D'Andrea discloses a book comprising all the elements as claimed in Claims 1 and 44, and as set forth above. D'Andrea further discloses wherein display items are affixed to the

interior of the covers (see Fig. 2) by “any conventional means” (Col. 4, lines 21-23). However, D’Andrea does not disclose wherein the affixing means is an aperture (not cut through the cover as defined by applicant).

ISBN discloses in Fig. 1-5, a book cover (A) wherein at least the interior of the cover defines apertures (C) in which an item can be attached to.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify D’Andrea’s book cover with an interior item receiving aperture as taught by ISBN for providing an alternative affixing means in which to secure an item to the cover.

***Allowable Subject Matter***

Claims 8, 10-32, and 45-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

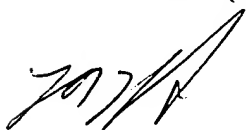
***Response to Arguments***

5. Applicant's arguments filed on December 6, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument's that the prior art does not disclose an aperture on the exterior of a book cover wherein the aperture is not cut all the way through the cover, the examiner submits that the D'Andrea reference is now used for disclosing an aperture on an exterior cover wherein the aperture is similar to a recess.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

August 3, 2006



MONICA CARTER  
SUPERVISORY PATENT EXAMINER